

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant	:	Tada, et al.
App. No.	:	10/537320
Filed	:	June 2, 2005
For	:	DENDRITE ELONGATION INHIBITOR FOR MELANOCYTE AND SKIN PREPARATION FOR EXTERNAL USE CONTAINING THE SAME
Examiner	:	Marcos Sznaidman
Art Unit	:	1628
Conf No.	:	3197

## REPLY BRIEF

**Mail Stop Appeal Brief-Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Appellants file this Reply Brief to address points raised in the Examiner's Answer sent April 6, 2011.

**Remarks/Arguments** begin on page 2 of this paper.

### **REMARKS**

Appellants add the following clarification regarding Attachment A (Jansen v. Rexall Sundown, Inc., 342 F3d 1329, Sept 8, 2003; hereafter “Jansen”), discussed in the Appeal Brief at page 11.

While Jansen pertains to the phrase “in need thereof”, the Examiner in rebuttal seems to focus on the “whereby” clause (page 13, last paragraph of Examiner’s Answer). Jansen was submitted to support Appellants’ position that patentable weight must be given to the recitation of “in need thereof”.

As stated on the 8<sup>th</sup> page of the “Jansen” Attachment A,

Just as in Rapoport, it is natural to interpret the nearly parallel language in the ’083 patent claims in the same way. In both Rapoport and this case, the claim preamble sets forth the objective of the method, and the body of the claim directs that the method be performed on someone “in need.” In both cases, the claims’ recitation of a patient or a human “in need” gives life and meaning to the preambles’ statement of purpose. See Kropa v. Robie, 187 F.2d 150, 152 (CCPA 1951) (stating the rule that a preamble is treated as a limitation if it gives “life and meaning” to the claim). The preamble is therefore not merely a statement of effect that may or may not be desired or appreciated. Rather, it is a statement of the intentional purpose for which the method must be performed. We need not decide whether we would reach the same conclusion if either of the “treating or preventing” phrase or the “to a human in need thereof” phrase was not a part of the claim; together, however, they compel the claim construction arrived at by both the district court and this court.

In the present case, the preamble is “for skin whitening” (claims 7, 12, 13, and 14) or “treating dyschromatosis” (claims 14, 16, 17) and the method is performed to “the skin of an individual in need of” the treatment recited in the preamble. In view of Jansen, such claim limitations must be considered.

The Examiner focuses entirely on the “whereby” clause to which he asserts “naturally flows from the teachings of the prior art” (page 13, last paragraph of Examiner’s Answer).

In contrast to the Examiner’s position, inhibition of elongation of melanocytic dendrites does not “naturally flow” from the teaching of Ishida as the compounds of Ishida do not significantly inhibit elongation of melanocytic dendrites. Therefore a person in need of skin

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whitening or in need of treatment for dyschromatosis by inhibition of elongation of melanocytic dendrites is not "in need of" the compounds taught by Ishida.

While the Examiner's position is that Ishida teaches compounds that are similar and have the same action as Centaureidin, Appellants' position is that Centaureidin is both structurally different and has a very different effect.

No fees are believed to be due. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 28, 2011

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